•• REMARKS/ARGUMENTS ••

The Official Action of June 28, 2004 has been thoroughly studied. Accordingly, the changes presented herein for the application, considered together with the following remarks, are believed to be sufficient to place the application into condition for allowance.

As requested by the Examiner on page 2 of the Official Action, applicant is submitting wherewith a Substitute Specification under 37 CFR §1.125 (a) together with a hand-marked-up copy of the original specification showing the changes made to the original specification.

The undersigned affirms that the Substitute Specification only contains the changes noted in the hand-marked-up copy of the original specification and does not contain any new matter.

Entry of the Substitute Specification is respectfully requested.

Also by the present Amendment the Abstract has been changed.

In addition, the claims have been changed in the manner courteously suggested by the Examiner.

Entry of the Substitute Specification, amendments to the Abstract and amendments to the claims are respectfully requested.

Claims 1-3 are pending in this application.

Claims 1-3 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over co-pending application serial no. 10/627,266.

Claims 1-3 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over co-pending application serial no. 10/627,267.

In response to the provisional obviousness-type double patenting rejections, the undersigned notes that applicant will be filing a Terminal Disclaimer to overcome this rejection in due course and the Examiner is requested to hold this provisional rejection in abeyance until an executed Terminal Disclaimer can be obtained and submitted. (This case was recently transferred to the undersigned, who does not have a power of attorney to sign a Terminal Disclaimer for the applicant)

Claim 1 stand rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 3,316,287 or G.B. 1,090,565 both to Nunn, Jr. et al.

In relying upon Nunn, Jr. et al. the Examiner states that:

> ...it would have been obvious to the skilled artisan to extrapolate, from the disclosures of Nunn, Jr. et al. '287 and Nunn, Jr., et al. (GB'565), the antistatic agent, as claimed, as per such having been within the purview of the general disclosures of Nunn, Jr. et al. '287 and Nunn, Jr., et al. (GB'565) and with a reasonable expectation of success.

This statement/position cannot support a rejection based on "anticipation" under 35 U.S.C. §102, let alone a rejection based upon "obviousness" under 35 U.S.C. §103.

As held by the CCPA in *In re Petering*:

> A prior art disclosure of a generic formula encompassing a vast number of compounds, including an applicants claimed compounds, does not by itself describe applicants claimed invention within the meaning of 35 USC 102. Rather, such a prior

art reference must further provide a more specific, limited teaching relating to the claimed compounds in order to anticipate the same. See *In re Petering,* 133 USPQ 275(CCPA 1962); *In re Ruschig*, 145 USPQ 274 (CCPA 1965); *In re Arkley*, 172 USPQ 524

A fair reading of the Nunn, Jr., et al. references will reveal that Nunn, Jr., et al. is directed to a generic formula that not only encompasses a vast number of compounds, but in addition, Nunn, Jr. et al. teaches that their compounds provide a vast array of functions and uses as noted, for example, in the paragraph bridging columns 5 and 6 of the U.S. patent.

Also note that Nunn, Jr. et al. teach that the organic polyalkyleneoxy borates range from viscous oils to waxy solids.

Most importantly, Nunn, Jr. et al. allows the integers "n" and "m" to range from 1 to 150 which encompasses a vast number of compounds that are excluded from applicant's claimed invention in which the sum of the integers $a + b + c + d + e + f$ is from 6 to 80.

Applicant's invention is a selective invention as compared with Nunn, Jr. et al. and is neither anticipated nor obvious over Nunn, Jr. et al.

Applicant's invention is directed to a more specific formula than taught by Nunn, Jr., et al. and a class of compounds that provide a particular mold release function that has been shown to be significant as compared to conventional mold release agents.

It accordingly cannot be stated that Nunn, Jr., et al. anticipates or in any way suggests, i.e. leads or directs one to applicant's claimed invention.

If the Examiner is taking the position that Nunn, Jr. et al. inherently encompass applicant's claimed invention, it is noted that inherency is immaterial if Nunn, Jr. et al. does not actually teach which of the organic polyalkyleneoxy borates are functionally useful as mold release agents or how to determine any generic formula of the polyalkyleneoxy borates which will provide the specific function as release agents.

Based upon the above, it is submitted that the Examiner cannot rely upon either of the references to Nunn, Jr. et al. under 35 U.S.C. §102 or §103 and therefore, the alternative prior art rejections based upon these references should properly be withdrawn.

It is believed that the above represents a complete response to the Official Action and reconsideration is requested.

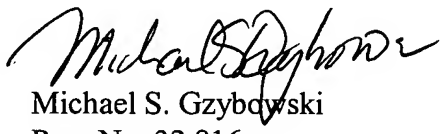
The prior art cited but not relied upon by the Examiner has been noted. This prior art is not believed to be particularly pertinent to applicants' claimed invention.

If upon consideration of the above, the Examiner should feel that there remain outstanding issues in the present application that could be resolved; the Examiner is invited to contact applicants' patent counsel at the telephone number given below to discuss such issues.

To the extent necessary, a petition for an extension of time under 37 CFR §1.136 is hereby made. Please charge the fees due in connection with the filing of this paper, including extension of

time fees, to Deposit Account No. 12-2136 and please credit any excess fees to such deposit account.

Respectfully submitted,



Michael S. Gzybowski
Reg. No. 32,816

BUTZEL LONG
350 South Main Street
Suite 300
Ann Arbor, Michigan 48104
(734) 995-3110

117828.1